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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,704	09/19/2005	Akihiro Kuroda	4710-0118PUS1	7682
2292 7590 01/27/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER GULLEDGE, BRIAN M				
ART UNIT 1619		PAPER NUMBER		
NOTIFICATION DATE 01/27/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/549,704

Applicant(s)

KURODA ET AL.

Examiner

Brian Guldge

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/DE)
Paper No(s)/Mail Date 9/19/2005: 12/19/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Auguste (US Patent Application Publication 2004/0197284; files May 23, 2003). Auguste discloses cosmetic compositions (title), and one composition recited comprises the silicone compound 1,1,1,5,5,5-hexamethyl-3,3-bis(trimethylsiloxy)trisiloxane in a physiologically acceptable medium (claim 30), which is the same silicone compound as recited in instant claim 1. The medium disclosed by Auguste includes mixtures of solvents miscible in water, such as ethanol and isopropanol (paragraph [201], lines 1-7). This composition anticipates the composition recited in instant claims 1 and 3-5.

Instant claims 17-21 recite a cosmetic composition with limitations to the process by which the tetraquasitrimethylsiloxysilane employed in the composition is prepared. Auguste does not disclose the method by which the 1,1,1,5,5,5-hexamethyl-3,3-bis(trimethylsiloxy)trisiloxane is prepared, however, the end product disclosed by Auguste has an identical structure to the product instantly recited. So, “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auguste (US Patent Application Publication 2004/0197284; filed May 23, 2003) in view of Kuroda et al. (European Patent Application Publication EP 1,213,006; published June 12, 2000). Auguste discloses all of the limitations of instant claim 2 except for the inclusion of methyltrimethicone.

Kuroda et al. discloses the use of the organopolysiloxane methyltrimethicone (paragraph [9], lines 1-3). This compound is taught for use in cosmetics in order to improve the stability of the cosmetic to low temperatures (storage) and simplify the production of the cosmetic product during colder months while maintaining a good skin feel (paragraph [5], line 1–paragraph [8], line 8). Kuroda et al. further discloses it is preferable to combine the use of the taught methyltrimethicone with other kinds of organopolysiloxanes used in cosmetics (paragraph 41], lines 1-2).

Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have added methyltrimethicone into the composition disclosed by Auguste, as Kuroda et al. teaches that by using methyltrimethicone in a cosmetic composition the cold stability and processing of the resultant cosmetic composition is improved.

Claims 6-16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auguste (US Patent Application Publication 2004/0197284; filed May 23, 2003). Auguste teaches the use of 1,1,1,5,5,5-hexamethyl-3,3-bis(trimethylsiloxy)trisiloxane in cosmetic compositions (see the above 102 rejection). Auguste also discloses the inclusion of non-volatile oils such as fluorosilicone (paragraph [199], last six lines) and that the form of the cosmetic is a water-in-oil emulsion (paragraph [215], lines 1-2), thus teaching all of the limitations of instant claims 6 and 7.

The specific combination of features claimed is disclosed within the broad genera of additional non-volatile oils and cosmetic forms taught by Auguste but such “picking and choosing” within several variables does not necessarily give rise to anticipation. *Corning Glass*

Works v. Sumitomo Elec., 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables, anticipation cannot be found.

That being said, however, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. *KSR v. Teleflex*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (*Id.*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Consistent with this reasoning, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have selected various combinations of non-volatile oils and cosmetic forms from within the disclosure of Auguste to arrive at compositions “yielding no more than one would expect from such an arrangement”.

Auguste also discloses the optional inclusion of phenylated polydimethylsiloxanes (paragraph [199], lines 52-55), pigments (paragraph [205], lines 1-3), polyisobutene (paragraph [199], lines 1-5), and sunscreens (paragraph [203], line 9) in the taught composition. Finally,

one form of the cosmetic taught by Auguste, a makeup remover, includes sucrose stearate, glycerol, and water (paragraph [219], example 5), and does not comprise the siloxane of formula (3) recited in instant claim 22. Thus, Auguste teaches all of the limitations of instant claims 8-16 and 22.

Claims 1-10, 12-15, and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi (US Patent Application Publication 2002/0114771; published August 22, 2002) in view of Kobayashi et al. (Japanese Patent Application Publication JP 11-217584; published August 10, 1999). To support this rejection, the provided machine translation of the above Japanese publication will be referenced.

Nakanishi discloses a cosmetic material (abstract, lines 1-3), that can be used to cleaning and removing makeup stains (paragraph [9], lines 1-14). The composition comprises branched silicone compounds to stabilize the emulsion form of the composition (paragraph [8], lines 1-8). However, Nakanishi does not disclose the inclusion of tetraquastrimethylsiloxysilane in the taught composition, as is recited by instant claims 1 and 17-21.

Kobayashi et al. discloses siloxanes that have improved detergency properties and are improved cleaning agents (paragraph [3], lines 1-5), as well as not requiring the use of environmentally undesirable halogenated solvents (paragraph [2], lines 1-15). The taught siloxanes include tetraquastrimethylsiloxysilane (paragraph [6], lines 1-8).

Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have used tetraquastrimethylsiloxysilane, as taught by Kobayashi et al., in the cleaning composition taught by Nakanishi. Kobayashi et al. taught that

tetraquimethylsiloxysilane has improved detergency, and is more environmentally friendly to produce.

Kobayashi et al. also discloses the inclusion of methyltrimethicone in the washing composition (paragraph [6], lines 1-6), teaching the limitation of instant claim 2. The composition taught by Nakanishi includes a solvent, such as ethanol (paragraph [282], example 21), thus teaching the limitations of instant claims 3-7. Nakanishi et al. also discloses the inclusion of nonionic surfactants in the composition, such as polyoxyalkylene-modified organopolysiloxanes and sorbitan fatty acid esters (paragraph [103], lines 1-19), teaching the limitations of instant claims 8-9 and 13. The branched silicone compounds disclosed by Nakanishi (discussed above) include phenyl-substituted silicone compounds (paragraph [15], lines 1-10), teaching the limitations of instant claim 10. Nakanishi also discloses the inclusion of pigments (paragraph [92], lines 1-12) and glycerin (paragraph [264], example 18), teaching the limitations of instant claims 11 and 14.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gullledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

**/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612**